

REMARKS

Claims 1-13 were pending in the present application. Claims 4 and 13 have been canceled, as such claims 1-3 and 5-12 are pending in the present application.

The Examiner has objected to the Figures for failing to include reference symbols as referenced in the Specification. The Examiner has objected to the Specification for failing to include a description for Figure 14a (the Examiner stated "Figure 15a", however Figure 15 as originally filed does not have an "a" symbol, therefore the Applicants assume the Examiner meant instead "Figure 14a"), and failing to disclose reference symbols not listed in the Figures. As such, the Applicants have amended Figures 1-9, 12, 14-16. The Applicants have amended the Specification to more clearly reference the specific Figures. As such, the Applicants request that the Examiner withdraw the objections to the Figures and the Specification. The Examiner's rejections will be dealt with in the order listed below:

- I. Claims 4 and 13 are rejected under 35 USC §112, first paragraph as allegedly failing to comply with the enablement requirement.
- II. Claims 1-13 are rejected under 35 USC §102(e) as allegedly being anticipated by Shanahan et al., US Patent Publication No. 2005/0022114 (hereafter Shanahan)

I. Claims 4 and 13 are enabled

The Examiner has rejected claims 4 and 13 under 35 USC §112, first paragraph as allegedly failing to comply with the enablement requirement. In particular, the Examiner suggests that "assessing the originality of said received document" as in claims 4 and 13 is not enabled. The Applicants respectfully disagree. However, without acquiescing to the Examiner's argument and to further the prosecution of the present application while retaining the right to prosecute the canceled (or similar claims) in the future, claims 4 and 13 have been canceled thereby rendering the Examiner's rejection moot. As such, the Applicants respectfully request that the Examiner withdraw the rejection.

II. Claims 1-13 are novel over Shanahan

The Examiner has rejected claims 1-13 under 35 USC §102(e) as allegedly being anticipated by Shanahan. The Applicants disagree. To anticipate a claim, the reference must teach each and every element of the claim as required by MPEP §2131.

The Examiner states that Shanahan discloses converting the unformatted document into a formatted document by reciting “*document content is detected and converted to a digital form*” (Office Action, page 5-6 #13). Shanahan discloses that upon scanning (512) a hardcopy document (614), the hardcopy document identifier and content are detected and converted to a digital form. Therefore, the hardcopy of Shanahan is converted to a digital, or electronic, form prior to being transmitted to the server (200) over the Intranet. However, the present claims go one step further, in that once the document is received over an electronic communication network, the systems and methods of the present invention convert digital, unformatted documents into formatted documents. Shanahan does not perform this conversion step of converting existing electronic documents to a standardized electronic document format. As such, Shanahan does not teach the claim element of “convert unformatted documents into formatted documents.”

The Examiner states that Shanahan discloses permitting a user to add contextual markups to the formatted document to generate a markup document (Office Action, pages 5-6 #13). The Applicants disagree with the Examiner’s interpretation of Shanahan. As previously stated, Shanahan does not disclose the conversion of a non-standardized electronic document to a standardized electronic document. As stated by the Examiner, Shanahan defines “annotate” as “*to create a reference between an entity in a document, or region of a document, and some set of links, text segment, images, or imbedded data*” (paragraph [0117]). This definition for “annotate” is consistent with a definition related to internal computer functions as evidenced when reading the definitions in context with Shanahan’s specification. The plain meaning of “annotate” should instead be applied where, for example, contextual markups are described as including editorial comments, corrections, annotations, comments, etc. (page 3 lines 24-25 of the specification), such that a reviewer might furnish with regards to a particular document he/she is reviewing.


Shanahan's definitions for "annotate" (for example, paragraphs [0297-0298] and [0340-0345]) and "markup" (for example, see paragraphs [0306-0308]) do not refer to, for example, textual criticisms and comments offered by a reviewer, but instead refer to user or system defined parameters for selecting parts of a document for linkage by, for example, Hyper Text Markup Language (HTML) or Extensible Markup Language (XML); two standard coding conventions for attaching linking attributes to informational content within a document as defined by the user or system. As such, Shanahan does not teach "permit a user to add contextual markups to formatted documents derived from said received document to generate a markup document."

As Shanahan does not teach each and every limitation of the claimed invention there can be no anticipation, and the Applicants respectfully request the Examiner withdraw the rejection.

CONCLUSION

All grounds of rejection of the Office Action of April 6, 2006 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicants encourage the Examiner to call the undersigned collect at 608-218-6900.

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